APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,332	01/26/2004	Takashi Ikeda	393032043200	9951

25224   7590   02/12/2008
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EXAMINER
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ART UNIT	PAPER NUMBER
3621	

MAIL DATE	DELIVERY MODE
02/12/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10/31/07</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-7, 9-19</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-7, 9-19</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>0924/07</u>.
4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. Request for Continued Examination under 37 CFR1.114, filed on 10/31/2007, has been

acknowledged. Claims 1-7, 9-19 are pending. The USPTO has considered applicant's

arguments/remarks, however, the prior art from the previous office action is maintained

because of any patentable distinction that may exist between current and previous claim

language is still unpatentable over the prior art.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
>> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 1-7, 9-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiser et al.

(U.S 6385596).

4.   As per claims 1-7, 9-19, Wiser et al. disclose a computer system that provides a secure

online music distribution system that provides consumers with flexibility and ease of use in the

selection, previewing, downloading, and transporting of audio and other digital media over the

Internet, and that provides for security of the media throughout the distribution system. The

computer system comprises of client/server architecture with a clients computer system

connected with a server online music distribution system that provides consumers with flexibility

and ease of use in the selection, previewing, downloading, and transporting of audio and other

digital media over the Internet, and that provides for security of the media throughout the

distribution system (column 3, lines 5-20), doing the following:

A. ("sending an order for requesting a purchase or a preview of a content of a music
performance to a server")--a delivery server 118 is responsible for receiving
requests from a media player (sending) 116 to preview or purchase a media data
file 200 containing audio data (C9, L56-59)– *Claims 1, 5, 19*

B. ("receiving song data from the server in response to the order, the song data being
composed of performance data and order information corresponding to the
performance data, performance data representing the content of the music
performance and containing reproduction limiting information for limiting a
reproduction state of the content of the music performance, the order information
indicating at least either a purchase or a preview associated with a usage right of
the content of the music performance") –the media player receives a media
voucher, which is an object that is used to control the purchase and preview of
media data files (C8, L19-20). The voucher uniquely identifies the media data
file (C8, L12). The voucher also limits the use of the media voucher 300 to a
single purchase or preview transaction (C8, L31-32). The aspect of using the

media voucher 300 to a single purchase or preview transaction (C8, L31-32) is a right that user has. The system also uses another data object called a passport that provides the security information particular to each user of the system (C8, L43-44)

C. ("determining whether the song data has already been stored in the storage") -- storing a plurality of media data files, each media data file including at least one audio image of a song encrypted with an associated media key, each media data file associated with a media ID for identifying the media data file (Claim 8). When distribution of media file is in order, the system authenticates the voucher ID and verifies the voucher by comparing against a previously authenticated voucher ID. Once the verification is positive, the media is distributed (Claim 8)

D. ("rewriting the order information contained in the stored song data with the order information contained in the received song data when the step of determining determines that the song data has already been stored and writing the received song data into the storage when the step of determining determines that the song data is not stored in the storage") (C17, L36-39)

E. The system allows a potential user to **preview a portion of a song** (column 7, lines 61-62, column 11, 39-44), to be played or stored on a client system -*Claims 1, 5, 19*

F. The system allows a potential user to **preview a portion of a song** (column 7, lines 61-62, column 11, 39-44), to be played or stored on a client system. The information about the duration of a song to be previewed tells a user that a 30

second preview of a 5-minute song will be reproduced or played for 30 seconds.

The remaining 4 minutes and 30 seconds of the songs will not be heard or

reproduced. *-Claims 1, 5, 19*

G. The media player is the mechanism by which the consumer plays back purchased

or previewed audio data, and by which the consumer digitally records purchased

media data files to a further external memory, such as a CD-Recordable, CD-RW,

Mini-Disc, flash memory, or the like. The media player provides user interface

controls for viewing lists of purchased and stored media data file, viewing cover

and promotional art and graphics, reading lyrics and other liner information,

organizing play lists and tracklists, and other music database management

features (column 10, lines 1-16) - *Claims 5, 19*

H. System limiting the reproduction/copies of content (column 3, lines 33-50,

column 4, lines 42-50, column 7, lines 27-37) – *Claims 1, 5, 9*

I. The system allows a potential user to preview a portion of a song (column 7, lines

61-62, column 11, 39-44), to be played or stored on a client system. The client

system can be any number of client devices (column 5, line 48) with media player

for playback and a browser (column 5, line 67) running, for example, on Apple or

Microsoft operating systems (column 6, lines 8-14). The invention contains a

server apparatus that store information regarding the song (for example: song title,

artist, preview, and purchase) (figure 8, column 14, lines 43-45). The prior art

also stores information such duration of the preview or song, song/preview size,

starting and ending times of the song/preview, fade-in and fade-out durations

(usage right of content), all of which is transferred to the client system (column 15, lines 56-61) - *Claims 1, 5, 9, 16-19*

J. The same interface allows a user to preview and purchase the same content (figures 8 and 14) to be delivered and stored on the client device (column 11, 39-44) - *Claims 1, 5, 9, 16-19*

K. The system enables prospective buyers of an audio content to clip portions of content, with a defined start and stop time for sampling/reproduction (column 7, lines 50-55) – *Claims 1, 2, 6, 10, 19*

L. Generation usage rights associated with the content (column 10, lines 45-47, column 11, lines 1-6) – *Claims 1, 5, 9*

M. Allowing users to store content in their hard disks (column 11, lines 42-45) - *Claims 1, 5*

N. The media player sets up communication channel with the specified delivery server and passes in the voucher ID and the media ID and bandwidth requirement. The media player also provides port information identifying which ports it is to receive the streamed audio data from the delivery serve (column 15, lines 33-43) - *Claims 3, 7, 11*

O. The audio content contains a mechanism that allow is to provide different functions such as quality levels on playback, using different sampling rates and compression levels. The mechanism also includes optional functions such as restrictions on playback and record to external devices or files (column 7, lines 4-16) – *Claims 4, 8, 12*

P.   An online music distribution system in accordance with the present invention includes a variety of cooperative components that communicate over a public network, preferably the Internet. These components include a content manager, one or more delivery servers, a media data file system and media information database. HTTP servers facilitate Internet communications by the system. Any number of individual purchasers use client computer systems with Web browsers and media players (column 3, lines 9-19) – *Claim 13*

Q.   Server is responsible for receiving requests from a media player to preview or purchase a media data file containing audio data (column 9, lines 56-58) - *Claim 13*

R.   Server transmitting the requested media file to the user (column 9, lines 60-67) - *Claim 13*

S.   The media files transmitted the user contains descriptive text, such as title, artist, lyrics, and liner notes, promotional art image data, and cover art image data (column 6, lines 59-62), and also contains mechanism to ensure usage rights are executed (column 7, lines 4-16) – *Claim 13*

T.   Once the audio is has been purchased, the server gives the user the appropriate licensing and updated its records accordingly (column 19, lines 11-49) - *Claim 14*

U.   The system enables prospective buyers of an audio content to clip portions of content, with a defined start and stop time for sampling/reproduction (column 7, lines 50-55), The media player sets up communication channel with the specified delivery server and passes in the voucher ID and the media ID and bandwidth

requirement. The media player also provides port information identifying which

ports it is to receive the streamed audio data from the delivery serve (column 15,

lines 33-43). The audio content contains a mechanism that allow is to provide

different functions such as quality levels on playback, using different sampling

rates and compression levels. The mechanism also includes optional functions

such as restrictions on playback and record to external devices or files (column 7,

lines 4-16) – *Claim 15*

Conclusion

5.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to EVENS J. AUGUSTIN whose telephone number is 571-272-

6860. The examiner can normally be reached on 10am - 6pm M-F.

6.   PTO highly suggest applicant to look into US 6226618 before responding to this office

action, as it may used alternatively as prior art against the claimed invention.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Fischer can be reached on (571)272-677979.

/Evens J. Augustin/
Evens J. Augustin
February 12, 2008
Art Unit 3621

DETAILED ACTION

7. Claims 1-35 are pending. Claims 1-23 and 31-35 have been examined.

8. OR- Request for Continued Examination under 37 CFR1.114, filed on 08/09/2007, has been acknowledged. Claims 34-44 have been added. Claims 1-44 are pending. The USPTO has considered applicant's arguments/remarks, however, the prior art from the previous office action is maintained because of any patentable distinction that may exist between and current and previous claim language is still unpatentable over the prior art.

Claim Objections

9. Claims 39-41 and 43-45 are objected to under 37 CFR 1.75(c) as being in improper form because they depend on other independent claims. Independent claims must not depend on other independent claims.

Specification Objections

10. The specification is objected to as failing to provide proper antecedent basis for the claimed

subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Specifically, the claims

contain the aspect of ("item rights expression overruling the repository right expression").

The USPTO was not able to find support for these claim languages in the specification. The

rules of the PTO require that application claims must "conform to the invention as set forth in

the remainder of the specification and the terms and phrases used in the claims must find

clear support or antecedent basis in the description so that the meaning of the terms in the

claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1). Correction

is required.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition
> of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requires of this title.

12. Claims 1, 41-42 and 45 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

13. For a claimed invention to be statutory, the claimed invention must be within the

technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

phenomena) that do not apply, involve, use, or advance the technological arts fail to promote

the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social

sciences, for example) and therefore are found to be non-statutory subject matter. A claim

limited to a machine or manufacture which has practical application in the technological arts

is statutory. In most cases, a claim to a specific machine or manufacture will have practical

application in the technological arts. See MPEP 2106, 2100-14 (quoting In re Alappat, 33

F.3d at 1544, 31 USQ2d at 1557). Additionally, for subject matter to be statutory, the

claimed process must be limited to a practical application of the abstract idea or

mathematical algorithm in the technological arts. See In re Alappat 33 F.3d at 1543, 31

USPQ2d at 1556-57 (quoting Diamond V. Diehr, 450 U.S. at 192, 209 USPQ at 10). For a

process claim to pass muster, the recited process must somehow apply, involve, use, or

advance the technological arts. See In re Musgrave, 431 F.2d 882, 167 USPQ 280 (CCPA

1970).

14. In the present case, claim 1 only recites an abstract idea. The recited steps of

collecting/analyzing data and predicting business events based on data collected/analyzed can

be performed in the mind of the user, and only constitute an idea.

15. As to technological arts recited in the preamble, mere recitation in the preamble (i.e.,

intended or field of use) or mere implication of employing a machine or article of

manufacture to perform some or all of the recited steps does not confer statutory subject

matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole

to breathe life and meaning into the preamble. Looking at the claims as a whole, nothing in

the body of the claims recite any structure or functionality to suggest that a computer

performs the recited steps. Claim 42 is rejected for the same reason. Claims 2-38 are

rejected as well, since they depend on claim 1.

16. As per claims 41 and 45, the preambles recite, "computer codes or instructions embodied on

a computer signal", however, do not recite that the computer program is encoded or recorded

on a physical medium readable by a computer. Thus, the claims are directed to functionally descriptive material that is not functionally or structurally interrelated to the medium. Data structures not claimed as embodied in computer readable media (defined as "a collective word for the physical material, such as paper, disk, and tape, used for storing computer-based information", Microsoft Press, Computer Dictionary, Second Edition, © 1994) are descriptive material per se and are not statutory because they are neither physical "things" nor statutory processes. Such claimed data structures do no define any structural and functional interrelationships between the data structure. See MPEP 2106(IV)(B)(1)(a).

Claim Rejections - 35 USC § 112 – 1st Paragraph

17. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

18. Claim1-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

19. The purpose of the requirement that the specification describe the invention in such terms that one skilled in the art can make and use the claimed invention is to ensure that the invention is communicated to the interested public in a meaningful way. The information

contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention.

20. Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. In re Wands, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.").

21. As per claims 1-42, they recite the steps of collecting/analyzing data and predicting business events based on data collected/analyzed, but the specification fails to disclose the specific and necessary software codes or instructions combined with the hardware that would enable one of ordinary skills in the art to realize the invention without undue experimentation.

Claim Rejections - 35 USC § 112 – 2nd Paragraph

22. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

23. Claims 1 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

    failing to particularly point out and distinctly claim the subject matter which applicant

    regards as the invention.

24. As per claims 1 and 42, the applicant recites the term "auto discovery analysis". The

    specification fails to clearly define to one of ordinary skills in the art the proper meaning of

    the term. The applicant must particularly point out and distinctly claim the subject matter

    which applicant regards as the invention. Claims 2-38 are also rejected as they depend on

    claim 1. In considering the claims as a whole, to determine whether the claims apprise one

    of ordinary skill in the art of its scope, the USPTO has found that the claims do not meet the

    threshold requirements of clarity and precision, and do not provide clear warning to others as

    to what constitutes infringement of the potential patent.

Claim Rejections - 35 USC § 102

25. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

    basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

26. Claims 1-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowman-Amuah

(U.S 6434568).

27. As per claims 1-28, Bowman-Amuah discloses an invention comprising of the following:

   A. Databases for storing information (column 2, lines 18-24)– *Claim 1*

   B. System provides real time monitoring tools (column 24, line 39, column 95, lines 1-5)

       - *Claim 1*

   C. Allow users to register (column 53, lines 40-44), and data management (column 34,

       line 32) – *Claims 1, 19*

   D. Bowman-Amuah et al. teach the aspects of retrieving data from a database, as well as

       manipulating the data (insert, update and delete) (column 52, lines 45-48). The prior

       art allows users to capture knowledge or content through the creation of unstructured

       information, i.e. documents. Access Services allow users to effectively retrieve

       documents that were created by them and documents that were created by others.

       Documents can be comprised of many different data types, including text, charts,

       graphics, or even audio and video (column 55, lines 32-38). The invention has Query

       tools to identify **class hierarchy** (column 185, lines 63-67) - *Claims 1, 19*

E. Bowman-Amuah et al. teach the aspect of data indexing, in which data can be located

   in database, using keyword searching. Furthermore, the prior can also search for

   additional words that have the same attributes. For example, if the user searches for

   auto, the system would also look for car, automobile, motor vehicle, etc (column 55,

   lines 53-67, column 56, lines 1-28) - *Claims 1, 19*

F. Users include internal users within a company or external users (column 103, lines

   21-23), and can be employees or vendors (column 103, lines 31-44)– *Claims 2-3*

G. Providing database libraries and classes (column 299, lines 34-35) – *Claims 4-5*

H. Class hierarchies and containment hierarchies provide a flexible mechanism for

   modeling real-world objects and the relationships among them (column 12, lines 57-

   59) – *Claim 6*

I. Class libraries are essentially collections of behaviors that you can call when you

   want those individual behaviors in your program (column 14, lines 29-31) – *Claim 7*

J. Business entities are represented as objects, which package data and functional

   behavior (column 127, lines 4-7) – *Claim 8*

K. Synchronization Services perform the transactions required to make one or more

   information sources that are intended to mirror each other consistent (column 51,

   lines 1-10) – *Claim 9*

L. The invention uses relational databases, thereby reduces data duplication (column 76,

   lines 64-67) - *Claim 10*

M. Storing object to a storage medium (column 294, lines 20-21) - *Claim 11*

N. Providing security control (column 53, lines 23-40), administration (column 121, lines 20-27) - *Claim 12*

O. Providing security control via firewalls (column 85, line 40) – *Claim 13*

P. Containing a central server (column 51, line 15) – *Claim 14*

Q. Real-time monitoring tools in the operations architecture (column 24, lines 38-39) - *Claim 15*

R. Providing a user interface (column 33, lines 22-23) – *Claim 16*

S. Providing search capability and search engine (column 56, lines 12-25) – *Claims 17, 19*

T. System being able to handle a large amount of data (column 234, lines 14-16) – *Claim 18*

U. Administrators establishing credentials (column 83, lines 56-60) – *Claims 19-20*

V. Administrator will have read-write-delete access to the database (column 53, lines 61-63) – *Claim 21*

W. Security components can restrict access to functions within an application based on a users security level. The highest level security is whether the user has access to run the application. The next level checks if the user has access to functions within the application, such as service calls or windows. At an even lower level, the security component could check security on more granular functions, such as widgets on a window (column 53, lines 45-52) – *Claim 22*

X. The system does an analysis for hierarchical relationships between organizations and/or people, a design pattern for maintaining an audit trail, a design pattern for

applying different levels of security to different user types, and a design pattern for

composite relationships between objects (column 134, lines 31-36) – *Claim 23*

Y. Data is intended to mirror each other consistent (column 51, lines 1-10) – *Claim 24*

Z. Providing fetching of data (288, lines 63, 67, column 291, line 60) – *Claim 25*

AA.   Different users have different privileges (column 53, lines 61-67) - *Claims 26-27*

BB.   Authentication includes user name/password (column 84, lines 32) – *Claim 27*

Claim Rejections - 35 USC § 103

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
> are such that the subject matter as a whole would have been obvious at the time the invention was made to
> a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

29. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman-Amuah

(U.S 6434568), in view of Williams (U.S 6304973).

30. As per claims 28, Bowman-Amuah's invention has been previously disclosed.

31. Bowman-Amuah did not explicitly describe a method/system that rates the security level of

content based on confidentiality and sensitivity. However, Williams describes an invention

relates to a multi-level security network system. More particularly, the present invention

relates to a secure communication between hosts using a network that implements a security

policy, and especially a network allowing multiple levels of information to coexist on a

network system. The system uses ratings requirements for multi-level secure (MLS)

systems. The term "multi-level security" refers to a system in which two or more

classification levels of information are processed simultaneously, and not all users are

cleared for all levels of information present (column 1, lines 25-29).

32. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the

applicant's invention to construct a system that would employ a method/system that rates the

security level of content based on confidentiality and sensitivity. It would have been obvious

to one of ordinary skill in the art at the time of the applicant's invention to implement a

method/system that rates the security level of content based on confidentiality and sensitivity

because it would prevent unauthorized parties from gaining access to the system (column 43,

line 32-33).

Conclusion

33. Examiner has pointed out particular references contained in the prior arts of record in the

body of this action for the convenience of the applicant. Although the specified citations are

representative of the teachings in the art and are applied to the specific limitations within the

individual claim, other passages and figures may apply as well. It is respectfully requested

that if the applicant is preparing to respond, to consider fully the entire references as

potentially teaching all or part of the claimed invention, as well as the context of the passage

as taught by the prior arts or disclosed by the examiner.

34. In determining patentability of an invention over the prior art, the USPTO has considered all

claimed limitations, and interpreted as broadly as their terms reasonably allow. Additionally,

all words in the claims have been considered in judging the patentability of the claims against

the prior art.

35. It should also be noted that, in the office action that:

A. Items in the rejection that are in quotation marks are claimed language/limitations.

B. Passages in prior art references may be mere rephrasing/rewording of claimed

limitations, but the implicit/explicit meaning of the references vis-à-vis the claimed

limitation remains intact.

C. Functional recitation(s) using the word "for" or other functional terms (*e.g.* "for

monitoring operation of a self service terminal application exceeded by a self service

terminal coupled to the computer" as recited in claim 8) have been considered but

given less patentable weight[1] because they fail to add any steps and are thereby

regarded as intended use language. To be especially clear, the Examiner has

considered all claim limitations. However the A recitation of the intended use of the

claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v.*

Ben Venue Laboratories, Inc., 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed.

Cir. 2001) (Where the language in a method claim states only a purpose and intended

result, the expression does not result in a manipulative difference in the steps of the

claim.).

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[1] See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that
although all limitations must be considered, not all limitations are entitled to patentable weight).

D. Limitations that recite the purpose of a process or the intended use of a structure are generally not given any patentable weight. Patentable weight is therefore given to the actual process steps or structural limitations.

E. Word(s) that are separated by "/" are being examined as being synonymous or equivalent.

F. "Processing device" is being interpreted as a Point Of Sale (POS) device or merchant device working in tandem with a secure processing server, and "portable device" is being interpreted as portable client or consumer device.

G. The claims are being analyzed as steps for collecting, analyzing business data and providing decisions based on the data collected and analyzed.

H. The USPTO interprets claim limitations that contain statement(s) such as "*if, may, might, can, could, when, potentially, possibly*", as optional language (this list of examples is not intended to be exhaustive). As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted *(In re Johnston*, 77 USPQ2d 1788 (Fed. Circ. 2006)). They will be given less patentable weight, because language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

I. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

J. Any official notices taken by the USPTO that are not adequately traversed by applicant will be taken to be admitted prior art.

K. The USPTO interprets common computer related words that are not lexicographically defined, in accordance to Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997[2]. The USPTO also uses published patent applications and issued patents as well, for meanings of common computer related words that are not lexicographically defined.

L. The USPTO asserts that, with regard to "means plus function" claim language, section 112 - paragraph 6 has not been invoked. Under section 112, paragraph 6, structure disclosed in the specification is "corresponding" structure "only if the specification or the prosecution history clearly links or associates that structure to the function recited in the claim." B. Braun Med., Inc. v. Abbott Labs., 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997). In this case, neither the specification or the prosecution history has clearly established the links or associates the corresponding structure to the function recited in the claim (s). "The duty of a patentee to clearly link or associate structure with the claimed function is the quid pro quo for allowing the patentee to express the claim in terms of function under section

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112, paragraph 6. Section 112, paragraph 6 was intended to allow the use of means

expressions in patent claims without requiring the patentee to recite in the claims all

possible structures that could be used as means in the claimed apparatus. However,

the price that must be paid for use of that convenience is limitation of the claim to the

means specified in the written description and equivalents thereof. If the

specification is not clear as to the structure that the patentee intends to correspond to

the claimed function, then the patentee has not paid that price but is rather attempting

to claim in functional terms unbounded by any reference to structure in the

specification. Such is impermissible under the statute."   Medical Instrumentation

and Diagnostics Corp. v. Elekta AB, 68 USPQ2d 1263, 1268 (Fed. Cir. 2003).

36. The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. The USPTO would highly suggest applicant to look into the following

application, as they very relevant that claimed invention.

- **Linehan (US 6327578)** - The method of the invention includes the step of sending

  from a consumer's computer a start message over an internet network to a merchant's

  computer. The merchant's computer then replies to the consumer's computer with a

  merchant message including a wallet initiation message, a merchant digital signature,

  and a digital certificate from an acquiring bank. The wallet initiation message

  includes a payment amount, an order description, a timestamp, and a nonce. This

  starts a consumer's wallet program in the consumer's computer in response to the

  wallet initiation message. The consumer's computer then sends over the internet

  network some consumer identity and authentication information, such as a userid and

user password, plus the merchant message, to an issuer gateway operating on behalf
of an issuing bank

- **Shwartz (US 20020013765)** - This invention relates to the execution of electronic
  transactions. More particularly this invention relates to a technique of obtaining
  authorization for an electronic transaction, such as a credit card transaction, from a
  responsible authority, without need for direct contact between a vendor and the
  authority.

- **Dulin et al. (US 20020029200)** - A system and method for facilitating electronic
  commerce by securely providing certificate-related and other services including
  certificate validation and warranty is disclosed. In a preferred embodiment, these
  services are provided within the context of a four-corner trust model. The four-corner
  model comprises a buyer, or subscribing customer, and a seller, or relying customer,
  who engage in an on-line transaction. The buyer is a customer of a first financial
  institution, or issuing participant. The issuing participant operates a certificate
  authority and issues the buyer a hardware token including a private key and a digital
  certificate signed by the issuing participant. The seller is a customer of a second
  financial institution, or relying participant. The relying participant operates a
  certificate authority and issues the buyer a hardware token including a private key and
  a digital certificate signed by the relying participant.

37. Any inquiry concerning this communication or earlier communications from the examiner
    should be directed to Evens Augustin whose telephone number is 571-272-6860. The
    examiner can normally be reached on Monday thru Friday 8 to 5 pm.

38. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Andrew Fischer can be reached on 571-272-6779.

/Evens J. Augustin/
Evens J. Augustin
February 12, 2008
Art Unit 3621